



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/237,194 01/26/99 BROWN

S HER011397

EXAMINER

LM02/0831

CHRISTENSEN O CONNOR
JOHNSON & KINDNESS PLLC
1420 FIFTH AVENUE SUITE 2800
SEATTLE WA 98101-2347

TKACS.S

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

08/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/237,194

Applicant(s)
Brown

Examiner
Stephen R. Tkacs

Group Art Unit
2761



☒ Responsive to communication(s) filed on 26 Jan 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7, 9, 11-14, 16-19, and 21-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 9, 11-14, 16-19, and 21-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2761

DETAILED ACTION

Response to Amendment

1. The amendment requesting the remaining claims to be renumbered has not been entered. 37 CFR 1.126 requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered.

Specification

2. The Abstract of the Disclosure is objected to because the first sentence is incomplete. Examiner suggests removing the word "which" on line 1. The punctuation is incorrect. Examiner suggests removing the comma after "or" on line 5. Correction is required. See M.P.E.P. § 608.01(b).

Claim Objections

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See M.P.E.P. § 608.01(n).

Art Unit: 2761

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 9, 11-14, 16-19, and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) As to claim 1, the language "operable for" on line 9 is vague and indefinite. It is unclear if the monitoring means is intended to be limited to actually monitor a condition indicative of a person's physical well being and produce digitally encoded signals representative of the monitored condition or just be capable of such. The language "said microprocessor-based unit being programmed for supplying a video signal" on lines 16 and 17 is incomplete. To what or to whom the video signal is supplied is not stated.

B) As to claim 13, the phrases "said one or more switches of said plurality of switches" on line 5, "said self-care health monitoring system" on line 6, and "said one or more switches" on

Art Unit: 2761

lines 7 and 8 have vague antecedent basis. Examiner suggests using consistent labeling to ensure clarity.

C) Claim 16 recites "the self-care health monitoring system of Claim 1;" however, claim 1 recites "a health monitoring system." Therefore, claim 16 is unclear.

D) As to claim 19, the language "operable for" on line 8 is vague and indefinite. It is unclear if the monitoring means is intended to be limited to actually monitor a condition indicative of a person's physical well being and produce digitally encoded signals representative of the monitored condition or just be capable of such. The language "said microprocessor-based unit being programmed for supplying a video signal" on lines 15 and 16 is incomplete. To what or to whom the video signal is supplied is not stated.

E) Claims 2-7, 9, 11-14, 16-18 and 21-23 are dependent claims and inherit the deficiencies of the claims on which they depend.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

Art Unit: 2761

In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 6, 7, 9, 11-14, 16-19, and 21-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,307,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are broader than the claims in the '263 patent, but do not recite features which are not obvious modifications of the claims of the patent.

Claim 1 of the '263 patent recites a programmable microprocessor-based unit, monitoring means, and a microprocessor-based data management unit. Claims 1 and 19 of the present application recite a programmable microprocessor-based unit, monitoring means, and a signal interface. The signal interface in the present application reads on the microprocessor-based data management unit as well as other signal interfaces, such as a direct connection. It would have been obvious to a

Art Unit: 2761

person of ordinary skill in the art to remove the microprocessor-based data management unit and connect the programmable microprocessor-based unit with the monitoring means with a hard-wired link. The courts have held that the elimination of an element and its function is not inventive step; therefore, a person of ordinary skill in the art would have been motivated to remove the data management unit of the '263 patent.

The dependent claims of the present application and those of the patent recite the same subject matter using different language and in varying levels of detail. However, Examiner holds that all of claims 1-3, 6, 7, 9, 11-14, 16-19, and 21-23 in the present case are obvious over claims 1-12 of U.S. Patent No. 5,307,263.

8. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Art Unit: 2761

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claims 1-15 and 19-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Fu et al.

A) As to claim 1, Fu et al. teaches a programmable microprocessor-based unit (60), the programmable microprocessor-based unit including a plurality of switches (74, 76), a memory unit that includes memory medium (80) having stored therein program instructions for controlling the operation of the programmable microprocessor-based unit, and circuit means for generating a video signal for causing display of information on a

Art Unit: 2761

video display unit (68) and monitoring means (94) operable for monitoring a condition indicative of a person's physical well-being and for producing digitally encoded signals representative of the monitored condition. Fu et al. also teaches signal interface means connectable in signal communication with the programmable microprocessor-based unit and the monitoring means. As described by the present specification, "in some situations, the interface unit may consist primarily or entirely of a conventional cable arrangement such as a cable for interconnection between RS232 data ports or other conventional connection arrangements" (page 27, lines 31-34). Therefore, the signal interface is shown in Fu et al. as the connector between monitoring means (94) and hardware bus (78).

Fu et al. does not teach a receptacle for the temporary insertion of an external memory unit. However, external memory units are old and well-known in the art and Applicant is given Official Notice of such. Such well-known memory units include floppy disks, external RAM and ROM cartridges, RAM and ROM cards, compact disks, magnetic stripe cards, removable hard drives, and magnetic tapes. These external memory units are used for storing data and programs. It would have been obvious to a person of ordinary skill in the art to use an external memory unit with the microprocessor-based unit in Fu et al. with the motivation of

Art Unit: 2761

permitting the external memory unit to be used with other microprocessor-based units and permitting other external memory units to be used with the microprocessor-based unit.

Fu et al. does not expressly teach the microprocessor-based unit being programmed for supplying a video signal for delaying information based upon the signal supplied by the monitoring means. However, Fu et al. does teach that the monitoring means is a glucose monitor (col. 6, lines 4-8). It would have been obvious to a person of ordinary skill in the art to display information monitored by the glucose module of Fu et al. One would have been motivated to do so because blood glucose data is critical to diabetic patients in planning food intake and insulin dosing.

B) As to claim 2, Fu et al. teaches that the monitoring means is a blood glucose monitor that produces digitally encoded signals representative of a user's blood glucose level (col. 6, lines 4-8).

C) As to claim 3, Fu et al. does not teach that the programmable microprocessor-based unit is a video game system. However, the phrase "video game system" is merely a label and does not carry any structural limitations. In fact, a system is a "video game system" only by virtue of its software, not its structure. Since the claimed apparatus is not stated to have

Art Unit: 2761

program instructions for playing a game, the label "video game system" is not given weight. However, it would have been obvious to include game programs in the Fu et al. system with the motivation of entertaining the patient when the microprocessor is not being used for monitoring the health of the patient.

D) As to claim 4, Fu et al. does not teach storing signals representative of the monitored condition in an external memory unit for subsequent access by a health care professional.

However, one of the inherent advantages of an external memory device is the ability to use the memory device in a plurality of computers. Therefore, it would have been obvious to a person of ordinary skill in the art to transfer data from the microprocessor-based unit to a health care professional by storing the data on the external memory device at the microprocessor-based unit, hand carrying ("sneaker net") or mailing the memory device to the signal processing means, inserting the external memory device into a receptacle which is connected to a computer, and reading the external memory device. One would have been motivated to modify the apparatus of Fu et al. in such a manner to permit data to be transmitted from the microprocessor-based unit to a health care professional without a hard-wired connection, thus providing a low cost transmission of data.

Art Unit: 2761

E) Claim 5 substantially repeats subject matter addressed above with respect to claim 2 and is rejected for the same reasons.

F) As to claim 6, Fu et al. teaches supplying encoded signals representative of the monitored condition, the encoded signals being established to allow transmission to a remote location (col. 12, lines 25-48). The health monitoring system of Fu et al. comprises signal transmission means (62) for supplying the encoded signals representative of the monitored condition to a medium that allows transmission of the encoded signals to a desired remote location.

G) Claim 7 substantially repeats subject matter addressed above with respect to claim 2 and is rejected for the same reasons.

H) Claim 8 substantially repeats subject matter addressed above with respect to claim 3 and is rejected for the same reasons.

I) As to claim 9, Fu et al. teaches that the desired remote location is a clearinghouse facility (col. 5, lines 48-52). The clearinghouse facility includes signal processing means (24) for converting the encoded signals representative of the monitored condition into a report that provides information relating to the monitored condition (col. 8, lines 4-10).

J) Claim 10 substantially repeats subject matter addressed above with respect to claim 3 and is rejected for the same reasons.

Art Unit: 2761

K) As to claim 11, Fu et al. teaches that the signal processing means of the clearinghouse facility includes means for electronically transmitting the report to a remotely located health care professional (30).

L) Claim 12 substantially repeats subject matter addressed above with respect to claim 2 and is rejected for the same reasons.

M) As to claims 13 and 14, Fu et al. does not teach the user controlling the operation of the microprocessor-based unit by operation of the switches in response to display of one or menus. However, menu-based programming is well-known in the art and Applicant is given Official Notice of such. It would have been obvious to a person of ordinary skill in the art to use menu-based programming in the Fu et al. system with the motivation of providing a user-friendly interface, thus making the system easy to use.

N) Claim 15 substantially repeats subject matter addressed above with respect to claim 3 and is rejected for the same reasons.

O) Claims 19-24 substantially repeat subject matter addressed above and are rejected for the same reasons.

Art Unit: 2761

11. Claims 16-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Fu et al. in view of Beckers.

As to claims 16-18, Fu et al. does not teach that the signal interface is a microprocessor-based data management unit. Beckers teaches a diabetes management system including a microprocessor-based data management unit which serves as a signal interface between a programmable microprocessor-based unit (recorder) and a clearinghouse facility (master computer) (Fig. 9; col. 2, lines 12-26; col. 9, line 21 to col. 10, line 55). It would have been obvious to use the signal interface of Beckers between the microprocessor-based unit of Fu et al. and the glucose monitor (94) and modem (92). One would have been motivated to combine the teachings of Fu et al. and Beckers to provide an intelligent interface between the microprocessor-based unit and the monitoring means of Fu et al., thus permitting a conventional, multi-purpose computer, rather than a dedicated computer, to be used as the programmable microprocessor-based unit.

Conclusion

12. This is a continuation of applicant's earlier Application No. 08/481,925. All claims are drawn to the same invention

Art Unit: 2761

claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

Art Unit: 2761

(703) 305-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-0040, (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Tkacs, whose telephone number is (703) 305-9774 and whose e-mail address is Stephen.Tkacs@uspto.gov. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached at (703) 305-9714. The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SRT
30Aug99



Stephen R. Tkacs
Primary Examiner